

## **REMARKS/ARGUMENTS**

### **I. General Remarks**

Claims 21-37 are currently pending. Claims 1-20 were previously cancelled in response to a restriction requirement. Claim 21 has been amended herein. Claims 30 and 32-35 have been cancelled herein. Claims 22, 25, 27 and 28 have been withdrawn in response to a species election. Claims 36-43 have been added. Applicants respectfully request that the above amendments be entered, and further request reconsideration in light of the amendments and remarks contained herein.

Applicants respectfully submit that these amendments add no new matter to the application and are supported by the specification as originally-filed. All the above amendments are made in a good faith effort to advance the prosecution on the merits of this case. Applicants thank the Examiner for his careful consideration of this application.

### **II. Remarks Regarding Rejections Under 35 U.S.C. § 102(b)**

Claims 21, 23, 24, 26, 29 and 31 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,964,291 issued to Bourne, *et al.* (hereinafter "*Bourne*"). With respect to this rejection, the Examiner writes that:

Bourne teaches a proppant material which comprises metal salts, such as magnesium chloride and calcium chloride (see example 2). The proppant is particulate as claimed in 31. Applicant's intended use as a tracking material does not distinguish (In re Pearson 181 USPQ 641).

(Office Action, at pages 2-3.)

In order to form a basis for a § 102(b) rejection, a prior art reference must disclose each and every element as set forth in the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2131 (2006). With respect to as-amended independent claim 21, *Bourne* does not disclose each and every element as set forth in the claim because *Bourne* does not disclose "a proppant composition comprising a particulate material associated with a tracking composition and a resin composition." Rather, *Bourne* discloses "proppant particulates that are of porous insoluble inorganic material, and are impregnated with a chemical treatment agent." (*Bourne*, Abstract). As such, *Bourne* does not disclose each and every element of Applicants' claims.

Consequently, for at least all the reasons stated above, Applicants respectfully submit that these claims are patentable over *Bourne*. Moreover, since "a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it

refers,” and since claims 23, 24, 26, 29 and 31 depend from claim 21, these dependent claims are allowable for at least the same reasons. *See* 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicants respectfully request the withdrawal of these rejections.

### **III. Remarks Regarding Rejection of Claims Under 35 U.S.C. § 102(e)**

The Examiner has rejected claims 21, 23, 24, 26, 29 and 31 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2004/0043906 issued to Heath *et al.* (hereinafter “*Heath*”) (Office Action at 3.) With respect to this rejection, the Examiner has stated:

Heath teaches a pelletized material which comprises metal salts and tracers, such as barite and particulate material such as sand (see 0018, 0019 and 0028). Applicant’s intended use as a proppant with tracking material does not distinguish (In re Pearson 181 USPQ 641).

(Office Action, page 3.) Applicants respectfully disagree.

With respect to as-amended independent claim 21, *Heath* does not disclose each and every element as set forth in the claim because *Heath* does not disclose “a proppant composition comprising a particulate material associated with a tracking composition and a resin composition.” Rather, *Heath* discloses “a spherical, plastic chemical release capsule.” (*Heath*, Abstract). As such, *Heath* does not disclose each and every element of Applicants’ claims.

Consequently, for at least all the reasons stated above, Applicants respectfully submit that these claims are patentable over *Heath*. Moreover, since “a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers,” and since claims 23, 24, 26, 29 and 31 depend from claim 21, these dependent claims are allowable for at least the same reasons. *See* 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicants respectfully request the withdrawal of these rejections.

### **IV. Remarks Regarding Rejections Under 35 U.S.C. § 102(a)**

Claims 21 and 29-31 stand rejected under 35 U.S.C. § 102(a) as being anticipated by European Patent Application No. 1132569 issued to Nguyen, *et al.* (hereinafter “*Nguyen*”). A rejection under § 102(a) may be overcome by a declaration under 37 C.F.R. § 1.132 showing that the reference is not by “another.” *See* M.P.E.P. § 706.02(a). Submitted herewith is Applicants’ declaration under 37 C.F.R. § 1.132 showing that the relevant disclosure in *Nguyen* is Applicants’ own work, and thus the invention disclosed therein is not “by another.” *See* M.P.E.P. § 706.02(b). Accordingly, Applicants respectfully submit that the 35 U.S.C. § 102(a)

rejection of claims 21 and 29-31 based on *Nguyen* has been overcome, and respectfully request the withdrawal of these rejections.

**V. No Waiver**

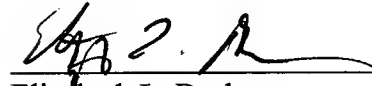
All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the cited references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements, such as, for example, any statements relating to what would be obvious to a person of ordinary skill in the art.

**SUMMARY**

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

The Commissioner is hereby authorized to debit the Deposit Account of Baker Botts L.L.P., Deposit Account No. 02-0383 in the amount of \$180.00 for the fee under 37 C.F.R. § 1.17(p) for consideration of an Information Disclosure Statement after mailing of the first Non-Final Office Action on the merits. Applicants believe that no additional fees are due in association with this filing. However, should the Commissioner deem that any fees are due, including any fees for extensions of time, Applicants respectfully request that the Commissioner accept this as a Petition Therefor, and direct that any additional fees be charged to Baker Botts L.L.P. Deposit Account No. 02-0383, Order Number 063718.1133.

Respectfully submitted,



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Date: April 20, 2007